

Mail Stop Interference  
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Paper 1

Filed 14 June 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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FRITZ H. BACH, LEO E. OTTERBEIN,  
MIGUEL P. SOARES and JEANNE GOSE,

Patent 7,238,469 B2,  
Junior Party,

v.

DAVID J. PINSKY, DAVID M. STERN  
and CHARLES J. PRESTIGIACOME,

Application 10/679,135,  
Senior Party,

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Patent Interference No. 105,815  
(Technology Center 1600)

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DECLARATION - Bd.R. 203(b)<sup>1</sup>

Part A. Declaration of interference

An interference is declared (35 U.S.C. § 135(a)) between the above-identified parties. Details of the application(s), patent (if any), reissue application (if any), count(s)

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<sup>1</sup> "Bd.R. x" may be used as shorthand for "37 C.F.R. ' 41.x". 69 Fed. Reg. 49960, 49961 (12 Aug. 2004).

and claims designated as corresponding or as not corresponding to the count(s) appear in Parts E and F of this DECLARATION.

Part B. Judge managing the interference

Administrative Patent Judge Sally Gardner Lane has been designated to manage the interference. Bd. R. 104(a).

Part C. Standing order

A Trial Section STANDING ORDER [SO] (Paper 2) accompanies this DECLARATION. The STANDING ORDER applies to this interference.

Part D. Initial conference call

A telephone conference call to discuss the interference is set for 2 August 2011 at 2:00 p.m. (the Board will initiate the call).

No later than four business days prior to the conference call, each party shall file and serve (SO ¶¶ 10.1 & 105) a list of the motions (Bd. R. 120; Bd. R. 204; SO ¶¶ 104.2.1, 120 & 204) the party intends to file.

A sample schedule for taking action during the motion phase appears as Form 2 in the STANDING ORDER. Counsel are encouraged to discuss the schedule prior to the conference call and to agree on dates for taking action. A typical motion period lasts approximately eight (8) months. Counsel should be prepared to justify any request for a shorter or longer period.

Part E. Identification and order of the parties

Junior Party

Inventors: Fritz H. Bach, MA  
Leo E. Otterbein, PA  
Miguel P. Soares, MA  
Jeanne Gose, MA

Patent: U.S. Patent 7,238,469 B2, issued 03 July 2007  
based on application 10/177,930,  
filed 21 June 2002

Title: Carbon monoxide improves outcomes in tissue  
and organ transplants and suppresses apoptosis

Real party in interest: Beth Israel Deaconess Medical Center, Inc., and  
Yale University

Senior Party

Inventors: David J. Pinsky, MI  
David M. Stern, GA  
Charles J. Prestigiacome, NJ

Application: Application 10/679,135,  
filed 03 October 2003

Title: Methods for treating ischemic disorders using  
carbon monoxide

Real party in interest: The Trustees of Columbia University in the  
City of New York

The senior party is assigned exhibit numbers 1001-1999. The junior party is assigned exhibit numbers 2001-2999. Bd. R. 154(c)(1); SO ¶ 154.2.1. The senior party is responsible for initiating settlement discussions. SO ¶ 126.1.

#### Part F. Count and claims of the parties

##### Count 1

Claim 46 of Pinsky (10/679,135) where the organ transplanted is a kidney, a small intestine, or skin.

The claims of the parties are:

Bach : 15, 18, 19, 37-39, and 46-48

Pinsky: 46, 49-51, 53, 56-62, 65, and 89

The claims of the parties which correspond to Count 1 are:

Bach : 15, 18, 19, 37-39, and 46-48

Pinsky: 46, 49-51, 53, 56-62, 65, and 89

The claims of the parties which do not correspond to Count 1, and therefore are not involved in the interference, are:

Bach : None<sup>2</sup>

Pinsky: None

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<sup>2</sup> All the other claims in the Bach involved patent were cancelled. (See interference 105,619 at Paper 42 (Judgment) and Paper 45 (Errata).

The parties are accorded the following benefit for Count 1:

Bach: 60/337,974, filed 07 Decemeber 2001

60/334,340, filed 29 November 2001

60/300,289, filed 21 June 2001

Pinsky: 09/671,100, filed 27 September 2000

PCT/US99/07175, filed 01 April 1999

Part G. Heading to be used on papers

The following heading must be used on all papers filed in this interference, see SO & 106.1.1:

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Part H. Order form for requesting file copies

When requesting copies of files, use of SO Form 4 will greatly expedite processing of the request. Please attach a copy of Parts E and F of this DECLARATION with a hand-drawn circle around the patents and applications for which a copy of a file wrapper is requested.

/Sally Gardner Lane/  
Administrative Patent Judge

Enc:

Copy of STANDING ORDER  
Form PTO-850

Revised 3 January 2006

cc (via Overnight Delivery):

Counsel for BACH:

FISH & RICHARDSON P.C. (BO)  
P.O. BOX 1022  
MINNEAPOLIS MN 55440-1022

Counsel for PINSKY:

COOPER & DUNHAM, LLP  
30 Rockefeller Plaza, 20th Floor  
NEW YORK NY 10112

Proposed count - clm 46 of 10/679135

# INTERFERENCE INITIAL MEMORANDUM

Count # \_\_\_\_\_

## To the Board of Patent Appeals and Interferences:

An interference is proposed involving the following two parties

PARTY Pinsky et al.	APPLICATION NO. 10/679,135	FILING DATE 03 October 2003	PATENT NO., IF ANY	ISSUE DATE, IF ANY
If the involved case is a patent, have its maintenance fees been paid? <input type="checkbox"/> Yes <input type="checkbox"/> No <input type="checkbox"/> Not due yet				
Proposed priority benefit (list all intervening applications necessary for continuity):				
COUNTRY	APPLICATION NO.	FILING DATE	PATENT NO., IF ANY	ISSUE DATE, IF ANY
U.S.	09/671,100	27 September 2000		
WO	PCT/US99/07175	01 April 1999		
The claim(s) of this party corresponding to this count:				
PATENTED OR PATENTABLE PENDING CLAIMS All (46, 49-51, 53, 56-62, 65, 89)			UNPATENTABLE PENDING CLAIMS None	
The claim(s) of this party NOT corresponding to this count:				
PATENTED OR PATENTABLE PENDING CLAIMS None			UNPATENTABLE PENDING CLAIMS None	
PARTY Bach et al.	APPLICATION NO. 10/177,930	FILING DATE 21 June 2002	PATENT NO., IF ANY 7,238,469	ISSUE DATE, IF ANY 03 July 2007
If the involved case is a patent, have its maintenance fees been paid? <input checked="" type="checkbox"/> Yes <input type="checkbox"/> No <input type="checkbox"/> Not due yet				
Proposed priority benefit (list all intervening applications necessary for continuity):				
COUNTRY	APPLICATION NO.	FILING DATE	PATENT NO., IF ANY	ISSUE DATE, IF ANY
U.S.	60/337,974	07 December 2001		
U.S.	60/334,340	29 November 2001		
U.S.	60/300,289	21 June 2001		
The claim(s) of this party corresponding to this count:				
PATENTED OR PATENTABLE PENDING CLAIMS 15,18,19 and 37-39			UNPATENTABLE PENDING CLAIMS None	
The claim(s) of this party NOT corresponding to this count:				
PATENTED OR PATENTABLE PENDING CLAIMS None			UNPATENTABLE PENDING CLAIMS None	
(Check off each step, if applicable) <b>INSTRUCTIONS</b>				
<input checked="" type="checkbox"/> 1. Obtain all files listed above. <input checked="" type="checkbox"/> 2. Confirm that the proposed involved claims are still active and all corrections and entered amendments have been considered. The patents must not be expired for, among other things, failure to pay a maintenance fee (Check PALM screen 2970). <input checked="" type="checkbox"/> 3. If one of the involved files is a published application or a patent, check for compliance with 35 U.S.C. 135(b). <input checked="" type="checkbox"/> 4. Obtain a certified copy of any foreign benefit documents where necessary (37 CFR 1.55(a)). <input checked="" type="checkbox"/> 5. Discuss the proposed interference with an Interference Practice Specialist in your Technology Center.				
DATE 27 May 2011	PRIMARY EXAMINER (Signature) /John Pak/		ART UNIT 1616	TELEPHONE NO. (571)272-0620
DATE 5/27/11	INTERFERENCE PRACTICE SPECIALIST or TECHNOLOGY CENTER DIRECTOR (signature) <i>John Pak</i>			TELEPHONE NO. 2-0562